

PROPOSED AMENDMENT
UNOFFICIAL COMMUNICATION—DO NOT FILE

higher volume discounts since more individual publications may be sorted to obtain larger volume discounts. Thus, by having the "sortation device" of claim 1 after the publications are merged, the co-mailer can maximize the mail rate discount from the conveyer when millions of publications must be co-mailed.

For these reasons, Claim 1 is not anticipated by the Mayer Reference and allowance is respectfully requested.

B. Dependent Claims 2-17

Claims 2 and 7 have been cancelled, without prejudice.

Claims 3-6, 8, 10-12, and 14-17 are dependent on claim 1 and are therefore not anticipated by the Mayer Reference for the same reasons provided above with regard to amended claim 1.

In addition to the dependence on claim 1, these dependent claims are patentable over the Mayer Reference in their own right. For example, claim 14 calls for a "verified sequence list" that is not taught or suggested by the Mayer Reference. Claim 15 calls for a "verified sequence list" and a "co-mailer merge and sequence module" that are not taught or suggested by the Mayer Reference.

C. Independent Claims 19, 24-28

Independent claims 19 and 24-27 have been amended to add the sortation device or the sorting step, where appropriate, and are therefore patentable over the Mayer Reference for the same reasons as provided above with regard to amended claim 1.

PROPOSED AMENDMENT
UNOFFICIAL COMMUNICATION—DO NOT FILE

D. Dependent Claims 20-23

Claims 20-23 ultimately depend from amended claim 19 and are therefore not anticipated by the Mayer Reference for the same reasons provided above with regard to amended claim 19.

V. Rejection of Claims 1-5, 9-12, 14-20, and 24-28 Under 35 U.S.C. §102(e)

The Examiner has rejected the above claims under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,445,975 (the Ramsey Reference).

The Ramsey Reference is purely a binding system and does not teach a co-mailer, or combining a bindery with a co-mailer. Since all the independent claims include a co-mailer, the Ramsey Reference does not anticipate those claims. Accordingly, the Applicant respectfully requests that this rejection be withdrawn.

VI. Rejection of Claims 13 and 21 Under 35 U.S.C. §103(a)

The Examiner has rejected dependent claims 13 and 21 under 35 U.S.C. §103(a) as anticipated by U.S. Patent No. 6,445,975 (the Ramsey Reference), in view of Grausher (U.S. Patent No. 5,025,610).

For the reasons provided above with regard to the Ramsey Reference, claims 13 and 21 are not rendered obvious by the Ramsey Reference, in view of Grausher, since there is no teaching or suggestion of a co-mailer in either reference. Applicant therefore respectfully requests that this rejection be withdrawn.

PROPOSED AMENDMENT
UNOFFICIAL COMMUNICATION—DO NOT FILE

VII. Allowable Subject Matter of Claims 22 and 23

The Applicant acknowledges the Examiner's allowance of dependent claims 22 and 23.

MAYER, BROWN, ROVE & MAW LLP
P.O. BOX 2828
CHICAGO, IL 60690-2828
850-331-2300 (PHONE)
850-331-2360 (FAX)

44006419.1

Serial No. 09/641,095
Express Mail No.

PROPOSED AMENDMENT
UNOFFICIAL COMMUNICATION—DO NOT FILE

VIII. Conclusion

For the foregoing reasons, the Applicant respectfully asserts that all claims are patentable over the cited prior art and respectfully requests that these claims be allowed.

No fee is believed due with this Response. Should additional fees be due, the Commissioner is authorized to charge any additional fees which may be required or credit any overpayment of fees, to Deposit Account No. 13-0019. A duplicate copy of this Authorization is enclosed.

Respectfully submitted,

 **DRAFT**

January __, 2004

Michael A. Molano
Attorney for Applicant
Reg. No. 39,777

CUSTOMER NO. 26565
MAYER, BROWN, ROWE & MAW LLP
P.O. Box 2828
Chicago, IL 60690-2828
650-331-2000 (Phone)
650-331-2060 (Fax)

MAYER, BROWN, ROWE & MAW LLP
P.O. Box 2828
CHICAGO, IL 60690-2828
(650) 331-2000 (PHONE)
(650) 331-2060 (FAX)

44006419.1

Serial No. 09/641,095
Express Mail No.

PROPOSED AMENDMENT
UNOFFICIAL COMMUNICATION—DO NOT FILE

In the Claims

Claims 1, 5, 6, 9-17, and 19-27 have been amended. Claims 3, 4, 8, and 18 are original claims. Claims 2 and 7 have been cancelled.

1. (currently amended) A system for combined mailing (co-mailing) of a plurality of diverse publications to a plurality of recipients ~~at an optimized mail rate~~, comprising:

a bindery for binding a plurality of signatures, the bindery binding the plurality of signatures to create a plurality of first publications and a plurality of second publications, each of the plurality of first publications and each of the plurality of second publications being in ~~an unique order~~, the ~~unique order~~ identifying each of the plurality of first publications and each of the plurality of second publications with each of the plurality of recipients; and

a co-mailer for combining the plurality of first publications with the plurality of second publications to form the plurality of diverse publications, the co-mailer comprising

a merge stream for merging the plurality of first publications and the plurality of second publications into the unique order to mail the plurality of diverse publications to the plurality of recipients; and

a sortation device for receiving the plurality of diverse publications merged by the merge stream and sorting each of the plurality of diverse publications by a mail rate at the optimized mail rate.

2. (cancelled)

3. (original) The system of claim 1, wherein the bindery binds the plurality of first publications and a second bindery binds the plurality of second publications.

PROPOSED AMENDMENT
UNOFFICIAL COMMUNICATION—DO NOT FILE

4. (original) The system of claim 1, wherein the plurality of diverse publications comprises magazines, catalogs, books or periodicals.
5. (currently amended) The system of claim 1, wherein the ~~unique~~ order is maintained in a verified sequence list, the verified sequence list being transferred from the bindery to the co-mailer.
6. (currently amended) The system of claim 1, further comprising:
a bindery bundling device for stacking, labeling and wrapping the plurality of publications in the ~~unique~~ order to be transferred to the co-mailer.
7. (cancelled)
8. (original) The system of claim 1, further comprising:
a bundling device for stacking, labeling and wrapping the plurality of diverse publications, the bundling device being coupled to and in communication with the co-mailer.
- [[8]]9. (currently amended) The system of claim 1, wherein the co-mailer further comprises:
a first print head, the first print head printing an mail-rate identifier information on each of the plurality of diverse publications in a customized orientation and a customized placement on a first portion of each of the plurality of diverse publications; and
a second print head, the second print head printing the mail-rate identifier information on ~~a second predetermined number~~ of each of the plurality of diverse publications in a customized orientation and a customized placement on a second portion of each of the plurality of diverse publications.

PROPOSED AMENDMENT
UNOFFICIAL COMMUNICATION—DO NOT FILE

10. (currently amended) The system of claim 1, wherein the co-mailer further comprising:
a co-mailer verification device, the co-mailer verification device verifying the ~~unique~~
order of each of the plurality of diverse publications using an identifier information.
11. (currently amended) The system of claim 1, wherein the bindery further comprises:
a bindery verification device, the bindery verification device verifying the ~~unique~~
order of each of the plurality of publications.
12. (currently amended) The system of claim 1, wherein the ~~unique~~ order is contained in
a verified sequence list for the plurality of publications, the verified sequence list created by a
bindery sequence list module in communication with a bindery control module, the bindery
control module transmitting the verified sequence list to the bindery for performing a first
print of an identifier information on each of the plurality of publications.
13. (currently amended) The system of claim 1, wherein the bindery further comprises:
a thickness measurement device for determining a thickness of each of the plurality of
publications; and
a weight measurement device for determining a weight of each of the plurality of
publications.
14. (currently amended) The system of claim 1, wherein the co-mailer further comprises:
a co-mailer merge and sequence module for receiving a plurality of verified sequence
lists from the bindery, each of the plurality of verified sequence lists containing the ~~unique~~
order for each of the plurality of publications received from the bindery, the co-mailer merge
and sequence module merging each of the plurality of verified sequence lists to create a

MAYER, BROWN, ROWE & MAW LLP
P.O. BOX 2828
CHICAGO, IL 60601-2828
850-331-2000 (PHONE)
850-331-2050 (FAX)

44006419.1

Serial No. 09/641,095
Express Mail No.

PROPOSED AMENDMENT
UNOFFICIAL COMMUNICATION—DO NOT FILE

merged verified sequence list, the merged verified sequence list sequenced in the ~~unique~~ order to determine ~~a~~ the optimized mail rate.

15. (currently amended) The system of claim 14, wherein the co-mailer further comprises:

a co-mailer control module, the co-mailer control module receiving the merged verified sequence list from the co-mailer merge and sequence module, the co-mailer control module transmitting the merged verified sequence list to the co-mailer for determining the optimized mail rate.

16. (currently amended) The system of claim 1, wherein the co-mailer further comprises:

a co-mailer control module for verifying on a merge stream on the co-mailer that each of the plurality of diverse publications are in the ~~unique~~ order.

17. (currently amended) The system of claim 1, wherein the co-mailer further comprises:

a co-mailer control module, the co-mailer control module driving ~~[[a]]~~ the ~~sortation device coupled and in communication with the co-mailer, the sortation device sorting each of the plurality of diverse publications by the optimized mail rate that are received from the co-mailer,~~ the co-mailer control module driving a bundling of the plurality of diverse publications leaving the sortation device.

18. (original) The system of claim 1, wherein the co-mailer further comprises:

a co-mailer control module, the co-mailer control module controlling a first print head and a second print head on the co-mailer, each of the first and second print heads printing an identifier information on each of the plurality of diverse publications in a customized

PROPOSED AMENDMENT
UNOFFICIAL COMMUNICATION—DO NOT FILE

orientation and a customized placement on a portion of each of the plurality of diverse publications.

19. (currently amended) A method for co-mailing of a plurality of diverse publications to a plurality of recipients at ~~an optimized mail rate~~, comprising:

providing an ~~unique~~ order to a bindery, the ~~unique~~ order defining an order that each of a plurality of publications are bound by the bindery;

binding, by the bindery, a plurality of signatures to create the plurality of publications, each of the plurality of publications being in the ~~unique~~ order;

~~co-mailing the plurality of diverse publications by~~ merging, by a co-mailer, the plurality of publications in the ~~unique~~ order to form the plurality of diverse publications;

sorting, by a sortation device, the plurality of diverse publications merged by a mail rate; and

sending the plurality of diverse publications to the plurality of recipients ~~at the optimized mail rate~~.

20. (currently amended) The method of claim 19, wherein the providing step further comprises:

providing the ~~unique~~ order in a form of a record list to a bindery sequence list module in communication with the bindery, the record list containing an identifier information for each of the plurality of recipients; and

sequencing the record list in a predetermined sequence to obtain a sequence list to ~~optimize the~~ used to determine a mail rate.

PROPOSED AMENDMENT
UNOFFICIAL COMMUNICATION—DO NOT FILE

21. (currently amended) The method of claim 20, wherein the binding step further comprises:

selecting the plurality of signatures based on at least one field in the record list for each of the plurality of recipients;

binding the plurality of signatures selected in the selecting step;

printing ~~an~~ the identifier information from the sequence list on the plurality of signatures;

determining a weight and a thickness of each of the plurality of publications, the weight and the thickness being inserted into the sequence list; and

verifying the ~~unique~~ order of each of the plurality of publications, the verifying step further comprising updating the sequence list to record each of the plurality of publications that are not in the ~~unique~~ order to generate a verified sequence list.

22. (currently amended) The method of claim 21, wherein the ~~co-mailing~~ merging step further comprises:

transferring a plurality of verified sequence lists to a co-mailer merge and sequence sort module in communication with the co-mailer, each of the plurality of verified sequence lists representing the plurality of publications;

merging, by the co-mailer merge and sequence sort module, the plurality of verified sequence lists into the ~~unique~~ order to obtain a merged verified sequence list;

using the merged verified sequence list to determine ~~the optimized~~ a mail rate for each record in the merged verified sequence list, the merged verified sequence list containing the ~~optimized~~ mail rate being an ~~optimized~~ merged verified sequence list;

PROPOSED AMENDMENT
UNOFFICIAL COMMUNICATION—DO NOT FILE

transferring the ~~optimized~~ merged verified sequence list to a co-mailer control module to drive the co-mailer;

inserting the plurality of diverse publications on a merge stream on the co-mailer;

verifying the unique order of each of the plurality of diverse publications on the merge stream using the identifier information;

printing an ~~optional endorsement line~~ the identifier information on each of the plurality of diverse publications;

verifying, after the printing step, the physical qualities of each of the plurality of diverse publications;

rejecting each of the plurality of diverse publications damaged during the co-mailing step and verified as damaged during the verifying step;

sorting each of the plurality of diverse publications by a mail rate category;

bundling a predetermined number of the plurality of diverse publications into a bundled plurality of diverse publications;

labeling the bundled plurality of diverse publications; and

transferring the bundled plurality of diverse publications to a postal office.

23. (currently amended) The method of claim 22, wherein the ~~co-mailing~~ merging step further comprises:

determining the ~~optimized~~ mail rate by:

determining, using the merged verified sequence list, a first group of the plurality of recipients within a five digit zip code;

determining, within the first group, a carrier route total number of the plurality of recipients within a first carrier route walk sequence;

44006419.1

Serial No. 09/641,095
Express Mail No.

PROPOSED AMENDMENT
UNOFFICIAL COMMUNICATION—DO NOT FILE

~~applying~~ assigning an enhanced carrier route mail rate when the carrier route total number is greater than a carrier route predetermined minimum;

determining, within the first group, a five digit number of the plurality of recipients within the five digit zip code not applied the enhanced carrier route mail rate;

~~applying~~ assigning a five digit zip code rate when the five digit number is greater than a five digit zip code predetermined minimum;

determining, within a second group, the second group having a plurality of recipients with diverse five digit zip code, a three digit zip code total number of the plurality of recipients within a three digit zip code not applied a five digit mail rate or a carrier route mail rate;

~~applying~~ assigning a three digit zip code mail rate when the three digit zip code total number is greater than a three digit zip code predetermined minimum; and

~~applying~~ assigning a standard mixed mail rate to a third group of recipients, the third group of recipients receiving the plurality of diverse publications remaining that are not in the first group or the second group.

24. (currently amended) A computer readable medium having computer instructions stored thereon that, when loaded into a computer system, cause the computer system to perform a method for co-mailing of a plurality of diverse publications to a plurality of recipients ~~at an optimized mail rate~~, the method comprising:

providing an unique order to a bindery, the ~~unique~~ order defining an order that each of a plurality of publications are bound by the bindery;

binding, by the bindery, a plurality of signatures to create the plurality of publications, each of the plurality of publications being in the ~~unique~~ order; and

44006419.1

Serial No. 09/641,095
Express Mail No.

MAYER, BROWN, ROWE & MANN LLP
P.O. BOX 2828
CHICAGO, IL 60620-2828
(650-381-2000 (PHONE))
(650-381-2050 (FAX))

PROPOSED AMENDMENT
UNOFFICIAL COMMUNICATION—DO NOT FILE

co-mailing a plurality of diverse publications, comprising

~~by merging the plurality of diverse publications in the unique order at the optimized~~
~~mail rate; and~~

sorting the plurality of diverse publications merged by the merge stream by a mail rate
to send the plurality of diverse publications to the plurality of recipients at the optimized mail
rate.

25. (currently amended) A system for co-mailing of a plurality of diverse publications to a plurality of recipients ~~at an optimized mail rate~~, comprising:

a co-mailer for combining the plurality of diverse publications, the co-mailer merging the plurality of diverse publications; and

a sortation device coupled and in communication with the co-mailer, the sortation device sorting each of the plurality of diverse publications from the co-mailer by ~~the a~~ optimized mail rate.

26. (currently amended) A method for co-mailing of a plurality of diverse publications to a plurality of recipients ~~at an optimized mail rate~~, comprising:

co-mailing the plurality of diverse publications by merging the plurality of diverse publications in a ~~unique~~ order; and

sorting each of the plurality of diverse publications from the co-mailer by ~~the~~ optimized a mail rate to deliver each of the plurality of diverse publications to the plurality of recipients at the ~~optimized~~ mail rate.

PROPOSED AMENDMENT
UNOFFICIAL COMMUNICATION—DO NOT FILE

27. (currently amended) A method for co-mailing a plurality of diverse publications to a plurality of recipients ~~at an optimized mail rate~~, comprising:

binding, by a bindery, a plurality of signatures to create a plurality of first publications and a plurality of second publications;

bindery printing, at the bindery, an identifier information on each of the plurality of publications to identify each of the plurality of recipients to receive each of the plurality of publications; and

co-mailing the plurality of diverse publications by

merging the plurality of first publications with the plurality of second publications, received from the bindery;

sorting, by a sortation device, the plurality of diverse publications merged by a mail rate; and

co-mailer printing ~~the optimized~~ a mail rate at the co-mailer on each of the plurality of diverse publications.

28. (original) A co-mailer for mailing a plurality of diverse publications, comprising:

a plurality of pockets for receiving the plurality of diverse publications;

a merge stream for receiving the plurality of diverse publications from the pockets;

a first print head in the merge stream, the first print head printing a mail rate on a predetermined number of each of the plurality of diverse publications in a customized orientation and a customized placement on a first portion of the predetermined number of the plurality of diverse publications; and

a second print head in the merge stream, the second print head printing the mail rate on a second predetermined number of the plurality of diverse publications in a customized

MAYER, BROWN, ROWE & MAW LLP
P.O. BOX 2828
CHICAGO, IL 60670-2828
606-301-2000 (PHONE)
606-331-2000 (FAX)

44006419.1

Serial No. 09/641,095
Express Mail No.

PROPOSED AMENDMENT
UNOFFICIAL COMMUNICATION—DO NOT FILE

orientation and a customized placement on a second portion of the second predetermined number of each of the plurality of diverse publications.

MAVER, BROWN, ROWE & MAW LLP
P.O. BOX 2825
CHICAGO, IL 60690-2825
820-331-2000 (PHONE)
820-331-2000 (FAX)

44006419.1

Serial No. 09/641,095
Express Mail No.